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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,270	10/09/2003	Peter Kleinschmidt	32860-000646/US	5989
7590 12/22/2006 Alexander Burke, Esq Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			EXAMINER	
			RANGREJ, SHEETAL	
			ART UNIT	PAPER NUMBER
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SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/22/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)				
Off: A 4' O	10/681,270	KLEINSCHMIDT, PETER				
Office Action Summary	Examiner	Art Unit				
	Sheetal R. Rangrej	3626				
The MAILING DATE of this communication apportant of the second	ears on the cover sheet with the c	orrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 6(a). In no event, however, may a reply be timil apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status	•					
1) Responsive to communication(s) filed on		•				
•	- action is non-final.	•				
•	, -					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims						
4)⊠ Claim(s) <u>1-18</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.	,					
6)⊠ Claim(s) <u>1-18</u> is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/or	election requirement.					
	1,					
Application Papers						
9) The specification is objected to by the Examiner.						
10)⊠ The drawing(s) filed on <u>09 October 2003</u> is/are: a)□ accepted or b)⊠ objected to by the Examiner.						
Applicant may not request that any objection to the d	• *					
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11)☐ The oath or declaration is objected to by the Exa	aminer. Note the attached Office	Action or form PTO-152.				
Priority under 35 U.S.C. § 119						
12)⊠ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a)⊠ All b)□ Some * c)□ None of: 1.⊠ Certified copies of the priority documents have been received.						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
	•					
Attachment(s)						
1) Notice of References Cited (PTO-892)	4) Interview Summary					
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date Notice of Informal Patent Application						
Paper No(s)/Mail Date <u>10/9/2003 and 12/22/2003</u> . 6) Other:						

• Claims 1-18 are pending.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has not been filed in parent Application No. 10/681270, filed on October 9, 2003.

Specification

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. The hyperlink is on page 3, paragraph 0009.

Drawings

3. Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 1, 2, and 3 (Figure 1). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will

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5. The drawings are objected to because many objects present in the drawings are not mentioned in the specification. For example, Figure 1 contains in the market place a broker and a health, but specification states that a marketplace is either a broker or an Internet forum; figure 1 also contains a double arrow between automated processing and health services connected by health programs, but there is no connection to that with the whole drawing. Many errors lie within all of the figures and corrections should be made. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

7. Claims 1, 11, and 12 of the instant application conflict with claims 1, 2, 3, and 13 of Application No. 10/681266. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

- 9. The following is a quotation of the second paragraph of 35 U.S.C. 112:
 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 10. Claims 1, 4, 6, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 11. Claim 1 recites the limitation of "set up a communication link to contracting parties when required" and "for producing encrypted data, which may be anonymous."

 It is unclear on the last limitation what is absolutely required by the claim and what is only recited in the alternative. It also appears that the claim only requires "at least one

of an e-commerce platform...and a marketplace connected to the providers," but then it's unclear whether the rest of the element "including a database..." etc. is also listed only in the alternative.

For examination purposes, the examiner will interpret the claim as if the requirements don't have to be met and the e-commerce platform or marketplace to include the database...etc.

- 12. Claim 4 recites the limitation "user inquiries regarding templates involve the structure of the health log also being sent." It is unclear whether the inquires, templates, or both are being sent and also sent where. For examination purposes, the examiner will interpret the claim as if the inquiries are being sent to receive responses.
- 13. Claim 6 recites the limitation "wherein a call center is arranged with at least one of the brokers the providers." It is unclear whether the call center is arranged with the brokers or the providers. For examination purposes, the examiner will interpret the claim to mean that the call center is arranged with either the broker or the provider.
- 14. Claim 10 recites the limitation "forward inquiries from the users anonymously to at least one of particular marketplaces and providers <u>and in order to transfer the tenders."</u> It is unclear whom the transfer of the tenders is being done to. For examination purposes, the examiner will interpret the tenders are being transferred to the user.
- 15. Claim 13 recites the limitation "user inquiries regarding templates involve the structure of the health log also being sent." It is unclear whether the inquires,

templates, or both are being sent and also sent where. For examination purposes, the examiner will interpret the claim as if the inquiries are being sent to receive responses.

16. Claim 15 recites the limitation "wherein a call center is arranged with at least one of the brokers the providers." It is unclear whether the call center is arranged with the brokers or the providers. For examination purposes, the examiner will interpret the claim to mean that the call center is arranged with either the broker or the provider.

Claim Rejections - 35 USC § 103

- 17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 18. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Patent 6,968,375) in view of Felsher (U.S. Publication 2002/0010679) and further in view of Umen et al. (U.S. Patent 5,734,883) and McNerney (U.S. Publication 2003/0088441).
- 19. As per claim 1, Brown teaches an e-commerce device having a personal electronic web health log, comprising:
 - a. A data interface including prestructured electronic forms for inputting personal health data (Brown: column 7, lines 22-23).

Brown does not teach a converter including data filters that do not permit interferences about the user's identity.

Felsher teaches a converter including data filters that do not permit interferences about the user's identity (Felsher: paragraph 0295).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown and Felsher's teachings. One of ordinary skill would have been motivated to combine these teachings because Felsher teaches that "while the medical data in the paper-based records is substantial, the ability to adequately index, store, and retrieve information from the paper-based mechanisms prevents efficient analysis of data" (Felsher: paragraph 0008, lines 10-14) and "while there are legitimate reasons for transmitting medical information files, such transmission must be limited to appropriate circumstances and to authorized recipients" (Felsher: paragraph 0012, lines 5-8).

Brown and Felsher do not teach an e-commerce platform with multiplicity of preproduced schemes selected on the basis of a template.

Umen teaches an e-commerce platform with multiplicity of pre-produced schemes selected on the basis of medical questions (Umen: claim 1, lines 5-10). In light of the specification, the examiner interprets "first predetermined format" to be the same as organized based on medical questions.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown in view of Felsher with Umen's teachings. One of ordinary skill would have been motivated to combine these teachings because McNerney teaches that "by switching from a traditional paper-based

information system to an electronic system powered by Internet technology, the healthcare industry can quickly realize dramatic cost savings" (McNerney: paragraph 0003, lines 1-4).

20. As per claim 2, the device of claim 1 is as described above.

Brown, Felsher, and McNerney do not teach wherein the templates are structured according to the health log forms.

Umen teaches wherein the templates are structured according to the health log forms (Umen: column 17, lines 31-34; column 17, lines 38-40). In light of the specification, the examiner interprets the detail object to be the same as a log form.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown in view of Felsher with Umen's teachings. One of ordinary skill would have been motivated to combine these teachings because Umen teaches that "it would be desirable to provide a system that would be adapted to arranging such information in the form of document that are compliant with each of the various manners which may be prescribed for such documents by U.S. or foreign regulatory agencies" (Umen: column 2, lines 57-62).

21. As per claim 3, the device of claim 1 is as described above. Brown further teaches wherein the template databases have a configuration device for matching templates to form structure in the user's health log (Brown: column 8, lines 32-36; column 7, lines 6-10). In light of the specification, the examiner interprets the script program generator to be the same as a configuration device.

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22. As per claim 4, the device of claim 2 is as described above. Brown further teaches user inquiries being sent (Brown: column 4, lines 60-63).

23. As per claim 5, the device of claim 1 is as described above.

Brown, Umen, and McNerney do not teach wherein the user and the providers have a broker interposed between them for the purpose of making the requests anonymous and/or for the purpose of checking and filtering the tenders

Felsher further teaches wherein the user and the providers have a broker interposed between them for the purpose of making the requests anonymous (Felsher: abstract, lines 14-17) and/or for the purpose of checking and filtering the tenders (Felsher: paragraph 0031). In light of the specification, the examiner interprets "servicing the customers" to include checking and filtering the tenders.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown with Felsher's teachings.

One of ordinary skill would have been motivated to combine these teachings because Felsher teaches that "while there are legitimate reasons for transmitting medical information files, such transmission must be limited to appropriate circumstances and to authorized recipients" (Felsher: paragraph 0012, lines 5-8).

24. As per claim 6, the device of claim 1 is as described above.

Brown, Umen, and McNerney do not teach wherein a call center is arranged with at least one of the brokers for the purpose of template consultancy.

Felsher further teaches wherein a call center is arranged with at least one of the brokers for the purpose of template consultancy (Felsher: paragraph 0031). In light of the specification, which states that consultancy is provided when template databases are too complicated for selection, the examiner interprets "servicing the customers" to include template consultancy, which in terms is checking and filtering.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown with Felsher's teachings.

One of ordinary skill would have been motivated to combine these teachings because Felsher teaches, "the use of an intermediary can protect user privacy" (Felsher: paragraph 0032, lines 1-3).

25. As per claim 7, the device of claim 1 is as described above.

Brown, Umen, and McNerney do not teach wherein contracting modules regulate the processing, including the billing, of the individual transactions between the users, brokers, and providers.

Felsher teaches wherein contracting modules regulate the processing, including the billing, of the individual transactions between the users, brokers, and providers (Felsher: paragraph 0011, lines 14-16). In light of the specification, the examiner interprets the third party to include users, brokers, and providers.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown with Felsher's teachings.

One of ordinary skill would have been motivated to combine these teachings because

McNerney teaches that "new cost cutting pressures have made it necessary for the industry" (McNerney: paragraph 0002, lines 7-9).

- 26. As per claim 8, the device of claim 1 is as described above. Brown further teaches wherein provider stations are provided with a service module in which analysis and advice modules, in conjunction with databases and an expert system, propose particularly effective advice and products on the basis of an analysis of the anonymous health data profiles (Brown: column 13, lines 32-36 and lines 43-44). In light of the specification, the examiner interprets communicating the messages to be the same as proposing advice and products.
- 27. As per claim 9, the device of claim 8 is as described above.

Brown, Umen, and McNerney do not teach wherein the service modules contain a connection to human experts for the purpose of checking the automatically created tenders to the user.

Felsher teaches wherein the service modules contain a connection to human experts for the purpose of checking the automatically created tenders to the user (Felsher: paragraph 0031).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown with Felsher's teachings.

One of ordinary skill would have been motivated to combine these teachings because Felsher teaches, "the use of an intermediary can protect user privacy" (Felsher: paragraph 0032, lines 1-3).

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28. As per claim 10, the device of claim 1 is as described above.

Brown, Umen, and McNerney do not teach wherein the broker station comprises a customer manager in order to forward inquiries from the user anonymously to at least one of particular marketplaces and providers and in order to transfer the tenders, which are preferably anonymous in terms of the provider names, to the users.

Felsher teaches wherein the broker station comprises a customer manager in order to forward inquiries from the user anonymously to at least one of particular marketplaces and providers and in order to transfer the tenders, which are preferably anonymous in terms of the provider names, to the users (Felsher: paragraph 0031). In light of the specification, the examiner interprets "servicing the customers" to include checking and filtering the tenders.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown with Felsher's teachings.

One of ordinary skill would have been motivated to combine these teachings because Felsher teaches, "the use of an intermediary can protect user privacy" (Felsher: paragraph 0032, lines 1-3).

29. As per claim 11, the device of claim 1 is as described above.

Brown further teaches a user interface protected by an authentication device, for inputting and maintaining the data in the personal health log (Brown: column 7, lines 22-23).

Brown does not teach a user interface for editing the template-generated schemes.

Umen teaches a user interface for editing the template-generated schemes (Umen: column 18, lines 52-64).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown in view of Felsher with Umen's teachings. One of ordinary skill would have been motivated to combine these teachings because Felsher teaches that "while the medical data in the paper-based records is substantial, the ability to adequately index, store, and retrieve information from the paper-based mechanisms prevents efficient analysis of data" (Felsher: paragraph 0008, lines 10-14) and "while there are legitimate reasons for transmitting medical information files, such transmission must be limited to appropriate circumstances and to authorized recipients" (Felsher: paragraph 0012, lines 5-8).

30. As per claim 12, the device of claim 11 is as described above.

Brown further teaches wherein the user interface includes at least one of a keyboard, or at least one interface to at least one of a card and label reader, and an interface to a remote controller (Brown: column 5, lines 61-65).

- 31. As per claim 13, the device of claim 3 is as described above. Brown further teaches user inquiries being sent (Brown: column 4, lines 60-63).
- 32. As per claim 14, the device of claim 2 is as described above.

Brown, Umen, and McNerney do not teach wherein the user and the providers have a broker interposed between them for the purpose of making the requests anonymous and/or for the purpose of checking and filtering the tenders

Felsher further teaches wherein the user and the providers have a broker interposed between them for the purpose of making the requests anonymous (Felsher: abstract, lines 14-17) and/or for the purpose of checking and filtering the tenders (Felsher: paragraph 0031). In light of the specification, the examiner interprets "servicing the customers" to include checking and filtering the tenders.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown with Felsher's teachings.

One of ordinary skill would have been motivated to combine these teachings because Felsher teaches that "while there are legitimate reasons for transmitting medical information files, such transmission must be limited to appropriate circumstances and to authorized recipients" (Felsher: paragraph 0012, lines 5-8).

33. As per claim 15, the device of claim 2 is as described above.

Brown, Umen, and McNerney do not teach wherein a call center is arranged with at least one of the brokers for the purpose of template consultancy.

Felsher further teaches wherein a call center is arranged with at least one of the brokers for the purpose of template consultancy (Felsher: paragraph 0031). In light of the specification, which states that consultancy is provided when template databases

are too complicated for selection, the examiner interprets "servicing the customers" to include template consultancy, which in terms is checking and filtering.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown with Felsher's teachings.

One of ordinary skill would have been motivated to combine these teachings because Felsher teaches, "the use of an intermediary can protect user privacy" (Felsher: paragraph 0032, lines 1-3).

34. As per claim 16, the device of claim 2 is as described above.

Brown, Umen, and McNerney do not teach wherein contracting modules regulate the processing, including the billing, of the individual transactions between the users, brokers, and providers.

Felsher teaches wherein contracting modules regulate the processing, including the billing, of the individual transactions between the users, brokers, and providers (Felsher: paragraph 0011, lines 14-16). In light of the specification, the examiner interprets the third party to include users, brokers, and providers.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown with Felsher's teachings.

One of ordinary skill would have been motivated to combine these teachings because McNerney teaches that "new cost cutting pressures have made it necessary for the industry" (McNerney: paragraph 0002, lines 7-9).

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35. As per claim 17, the device of claim 2 is as described above. Brown further teaches wherein provider stations are provided with a service module in which analysis and advice modules, in conjunction with databases and an expert system, propose particularly effective advice and products on the basis of an analysis of the anonymous health data profiles (Brown: column 13, lines 32-36 and lines 43-44). In light of the specification, the examiner interprets communicating the messages to be the same as proposing advice and products.

36. As per claim 18, the device of claim 17 is as described above.

Brown, Umen, and McNerney do not teach wherein the service modules contain a connection to human experts for the purpose of checking the automatically created tenders to the user.

Felsher teaches wherein the service modules contain a connection to human experts for the purpose of checking the automatically created tenders to the user (Felsher: paragraph 0031).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Brown with Felsher's teachings.

One of ordinary skill would have been motivated to combine these teachings because Felsher teaches, "the use of an intermediary can protect user privacy" (Felsher: paragraph 0032, lines 1-3).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheetal R. Rangrej whose telephone number is 571-270-1368. The examiner can normally be reached on 4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRR

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